

REMARKS

The above amendments and these remarks are responsive to the final Office action dated February 22, 2006 and support the accompanying Request for Continued Examination as a submission under 37 C.F.R. § 1.114.

Prior to entry of the above amendments, claims 1-9, 11-19, and 21-25 were pending in the application. The Office action can be summarized as follows:

- Claims 1-9, 11-19, and 21-25 were rejected under the judicially created doctrine of obviousness-type double patenting.
- Claims 1-9, 11-19, and 21-25 were rejected under 35 U.S.C. §103(a) as being unpatentable over either U.S. Patent No. 5,990,205 to Cordova (“Cordova”), or U.S. Patent No. 5,333,405 to Bowles (“Bowles”) in view of either U.S. Patent No. 5,698,210 to Levy (“Levy”) or U.S. Patent No. 5,432,000 to Young, Sr. et al. (“Young”), and further in view of U.S. Patent No. 5,612,397 to Gebhard (“Gebhard”) and U.S. Patent No. 4,859,242 to Hughes et al. (“Hughes”).

By the above amendments, claim 1 is amended. In view of the foregoing amendments, and the following remarks, Applicants respectfully request reconsideration of the application under 37 C.F.R. § 1.111.

Request for Continued Examination

Applicants are submitting herewith a Request for Continued Examination (RCE) under 37 C.F.R. § 1.114. This Request complies with the requirements of

37 C.F.R. § 1.114. In particular:

- (i) Prosecution in the application is closed, since the last action was a final Office action under 37 C.F.R. § 1.313.
- (ii) The Request is accompanied by a submission as set forth at 37 C.F.R. § 1.114(c), specifically, the accompanying amendment and remarks.
- (iii) The Request is accompanied by the fee set forth at 37 C.F.R. § 1.17(e).

Accordingly, Applicants respectfully request grant of this Request for Continued Examination.

Double Patenting Rejections

In the Office action, all presently pending claims were rejected under the doctrine of obviousness-type double patenting over Applicants' U.S. Patent No. 6,503,582. The Examiner indicated that the obviousness-type double patenting rejection could be maintained, because the scope of the claims as originally filed had changed. Specifically, Applicants understand that the Examiner's position is that the prior amendment to the preamble of claim 1 to add "for use in a children's amusement device" changed the scope of the claim and therefore rendered the claim to be subject to an obviousness-type double patenting rejection despite the prior restriction between the original composition claims and the patented method/apparatus claims.

Applicants respectfully traverse the propriety of the obviousness-type double patenting rejection. The rejection was made between the composition and the patented method/apparatus without regard to the subject matter of the composition claims, and Applicants submit that the obviousness-type double patenting rejection therefore should

be withdrawn in view of the prior restriction. However, and in an effort to advance prosecution of the present application, Applicants have amended the claims from an “absorbent composition *for use in a children’s amusement device...*” to simply an “absorbent composition....” During the prosecution of the application from which the ‘582 patent issued, restriction was made between claims directed to the compositions disclosed in the application and the articles and methods disclosed in the application. As set forth in the Supplemental Notice of Allowance issued on October 1, 1999 in the parent application (Serial No. 08/914,438), restriction was made between original claims 1-19, drawn to a composition classified in class 521, subclass 59, and to claims 20-44, drawn to an article and a method classified in class 446, subclass 320. During the prosecution of the parent application, election was made to pursue the article and method claims, and the composition claims (claims 1-19) were accordingly cancelled without prejudice. In view of the above-discussed amendment, the scope of the presently pending claims are the same as originally filed. The scope of the pending claims in the present application is therefore consonant with the restriction requirement made by the Examiner in the parent application. Accordingly, Applicants request reconsideration and withdrawal of the obviousness-type double patenting rejection.

Rejections under 35 USC § 103(a)

Claims 1-9, 11-19, and 21-25 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Cordova or Bowles in view of Levy or Young, and further in view of Gebhard and Hughes.

As amended, claim 1 recites an “absorbent composition consisting essentially of a dry granular mixture comprising a granular superabsorbent polymer, a granular gum, granular gelatin and a granular binder.” As discussed in more detail at page 16, lines 10-18 of Applicants’ specification, the dry granular composition is deposited, or poured, onto the base of a play structure during use. With the addition of fluid, the absorbent composition expands to fill the shape of the play structure. As discussed in more detail at page 17, lines 11-18, of the specification, the play value of the claimed composition may include the fact that dry granular material may be selectively deposited within a play structure, and then a child can selectively hydrate the composition to watch it grow, shine, and appear “life-like.” The dry granular nature of the composition is thus the feature that allows a child to selectively pour the material within a play structure.

Although many of the dependant claims recite that the composition is configured or adapted to behave in a specific manner upon the addition of water, these claims are not intended to cover wet mixtures. Rather, they are intended to further define the scope of the claimed absorbent composition, by describing properties of the claimed composition that enable it to behave in a particular manner upon the addition of water.

Referring to the cited art, Applicants agree with the Examiner that Cordova discloses the use of a gum, a gelatin, a binder, a colorant, reflective metal particles, and a preservative in an elastic molding material. However, the composite material disclosed in Cordova is a cohesive molding plastic. As discussed at column 5,

line 44, to column 6, line 4, the base material of Cordova is a liquid solution of polyvinyl alcohol dissolved in water (lines 46-47), to which glycerin, gum, and propylene glycol are added (lines 62-65). The final mixture disclosed in Cordova, which includes some of the components recited in claim 1, is a nondrying plastic moldable composition (column 7, lines 45-46), which has a high degree of elasticity, or bounce (column 7, lines 56-58). This material is completely different from the dry granular mixture recited in claim 1. Thus, Cordova does not disclose or suggest a dry granular mixture, let alone a mixture having a granular superabsorbent polymer, a granular gum, granular gelatin and a granular binder.

Perhaps more importantly, Cordova specifically teaches away from such a dry granular mixture. As indicated above, the final mixture disclosed in Cordova is a *nondrying* plastic moldable composition (column 7, lines 45-46). Each “mixture” disclosed in Cordova is thus formed by dissolving the various components in a reaction solvent that in turn causes various components to cross-link with one another to form a gel-like plastic. Although the present application’s specification discloses that a solvent, namely water, can be added to the composition, the specification also discloses that the composition can be dehydrated. Further, the dry granular composition recited in claim 1 would be inoperable as an elastic molding plastic, as a dry mixture by definition does not include any solvents that would enable a cross-linking reaction. As Cordova teaches a cross-linked gel-like composition, Cordova teaches away from forming any composition consisting essentially of a dry granular mixture of materials.

Bowles also fails to disclose or suggest the dry granular mixture recited in amended claim 1. Bowles discloses a fishing lure that includes microencapsulated liquid fish attractants. While Applicants agree with the Examiner that Bowles discloses a composite material that includes a binder, a gum, and a gelatin, Bowles clearly does not disclose a dry granular mixture that includes the binder, the gum and gelatin. As discussed at column 7, line 46, to column 8, line 50, the Bowles composite material is prepared by forming a polymer solution of gelatin and water (see column, 7 lines 55-61), which is subsequently chemically hardened. Thus, the gelatin is first dissolved in a liquid, and is then included in a hardened composite material capable of encapsulating a liquid fish attractant. The composite material of Bowles is specifically stated as forming a “microencapsule solid wall material by coacervation, permitting the incorporation of liquid fish attractant.” See column 6, lines 65-68. Further, at column 7, lines 16-26, Bowles states that the binder component permits the composite to remain “stable in a tacky, viscous state” until molded onto the fishing lure. Thus, the final mixture disclosed in Bowles, which may include a binder, a gum and gelatin, is either wet, or is formed into a dry solid microcapsule for retaining liquid fish attractant. Neither of these forms are a dry granular mixture, much less the dry granular mixture recited in claim 1. Bowles therefore does not disclose or suggest a dry granular mixture, let alone a mixture having a granular superabsorbent polymer, a granular gum, granular gelatin, and a granular binder.

The encapsulating material of Bowles further teaches away from forming the dry granular absorbent composition of claim 1. Specifically, an essentially granular composition would be inoperable as a composite material to encapsulate fish attractants, and to, at least in part, retain the fish attractant onto a fishing lure. As indicated above, Bowles specifically teaches using a binder so that the Bowles composition can be retained in a wet state (i.e. “a tacky, viscous state”) until the moment when it is used to form the hardened microencapsulating solid. Because mixtures containing binders are either wet, or in solid microencapsulating form, these mixtures are never granular. Further, any conceivable combination involving Bowles to create the essentially granular composition of claim 1 would be incapable of microencapsulating fish attractant, or of being fixedly positioned on a fishing lure.

Thus, neither of the Cordova or Bowles primary references provides any teaching or suggestion to be combined with any other references of record to form the dry granular composition of independent claim 1, and further, both Cordova and Bowles teach away from such a granular composition. For at least the above reasons, Applicants submit that amended claim 1 patently distinguishes each of the suggested combinations including Cordova or Bowles. Accordingly, Applicants request withdrawal of the rejections of claim 1 and dependent claims 2-9, 11-19, and 21-25.

In response to arguments similar to those presented above, the Examiner asserted in the Office action that:

The instant claims do not exclude the addition of a fluid or solvent, such as water. The recitations of "granular" are not deemed relevant to patentability. The recitations do not lend patentability to the claims since the specific form of the ingredients would be a matter of choice to the skilled artisan...The form of the product does not lend patentability to the claims in a composition where the constituents of that composition are employed in art-recognized functions, as herein. This is especially true herein since the application of a fluid or water is intended by the user as asserted at page 11, 2nd full paragraph, of the Specification. The instant claims do not exclude such addition, as pointed out above. Further, the encapsulating material disclosed by Bowles is not excluded by the claim recitations herein.

Applicants respectfully disagree with these arguments as they pertained to the previously presented claims. However, as discussed above, the claims have been amended to more particularly point out that the scope of the claims only includes dry granular mixtures of the various recited granular components. The amended claims thus explicitly exclude mixtures that include an added fluid or solvent.

Applicants further submit that none of the secondary references, Levy, Young, Gebhard, or Hughes, teach or suggest a combination with either primary references Cordova or Bowles which would result in the dry granular mixture recited in claim 1. Levy discloses a coating composition capable of incorporating, and gradually releasing, bioactive agents to a water column (Levy column 6, lines 5-9), and does not disclose dry granular mixtures of granular components that may be selectively deposited by a child within a play structure. Young discloses a composition including a superabsorbent polymer and a binder which may be adhered to fibers (Young column 11, lines 3-7), and does not disclose a dry granular mixture. Gebhard discloses a mixture including glitter that is added to, and suspended in, an aqueous binder to create a glossy composition capable of being applied to clothing (Gebhard

column 7, lines 21-35), and Hughes discloses a dye composition of color agents and glitter (Hughes column 2, lines 19-36). Each and every one of these secondary references fails to provide any teaching or suggestion to motivate one skilled in the art to form combinations with primary references Cordova or Bowles that would result in the dry granular mixture recited in amended claim 1. Accordingly, Applicants assert that amended claim 1 and dependent claims 2-9, 11-19 and 21-25 patently distinguish all references of record.

With the entry of the above amendments, and for the reasons stated, Applicants submit that all of the issues raised in the Office action have been addressed. If the Examiner has any questions or if there are any remaining issues, Applicants request a telephone interview with the Examiner to discuss any such questions or remaining issues and to therefore not further delay prosecution of the present application. Applicants' undersigned attorney may be reached at the number listed below.

Respectfully submitted,

KOLISCH HARTWELL, P.C.

A handwritten signature in dark ink, appearing to read 'David S. D'Ascenzo', is written over a horizontal line.

David S. D'Ascenzo
Registration No. 39,952
PTO Customer No. 23581
Kolisch Hartwell, P.C.
520 S.W. Yamhill Street, Suite 200
Portland, Oregon 97204
Telephone: (503) 224-6655
Facsimile: (503) 295-6679